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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------------|------------------|
| 10/690,953 | 10/22/2003 | Richard R. Roesler | M | 6423 |
| 157 | 7590 | 04/23/2004 | -7252C/MD-01-113-LS-C | |
| BAYER POLYMERS LLC 100 BAYER ROAD PITTSBURGH, PA 15205 | | | EXAMINER MOORE, MARGARET G | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1712 | |
| DATE MAILED: 04/23/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary

Application No.

10/690,953

Applicant(s)

ROESLER ET AL.

Examiner

Margaret G. Moore

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 to 6, 10 to 20 is/are rejected.
- 7) ☒ Claim(s) 7 to 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 to 6 and 10 to 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stuart.

Stuart teaches silylated polyethers. The polyethers are reacted with a diisocyanate compound. See for instance the bottom of column 5, which teaches NCO:OH ratios within the claimed range. The isocyanate polyether is subsequently reacted with a silane meeting formula (I) or (IV). See also the bottom of column 5 which teaches an amine: isocyanate ratio within that claimed. The teachings on the bottom of column 6 through column 7 detail the particular silanes of formula (I) and (IV). This also meets the limitations of claims 2, 3 and 10 to 15.

Column 6, lines 10 to 25, details the polyether polyols. These polyols meet the claimed molecular weight limitation (including that in claims 16 to 20) and can have a monol content which is preferably kept below 31%. Any monol content above 10% will meet the proviso that a-ii) and b-ii) add up to at least 10. The clearly delineated upper limit of 31% monol anticipates the monol content required as compound a-ii). This also meets the limitations of claims 4 to 6 and 10 to 15.

Stuart differs from that claimed in that patentee does not teach a degree of unsaturation for the polyol. Adjusting the degree of unsaturation in the polyol of Stuart, however, would have been within routine experimentation for one having ordinary skill in the art. The Examiner notes too that Stuart prefers the polyols under the trade name Acclaim and applicants use polyols having the same trade name in the working examples. It would appear then that the unsaturation content in these polyols would be consistent, leading one to expect that the polyols in Stuart would meet that claimed, or

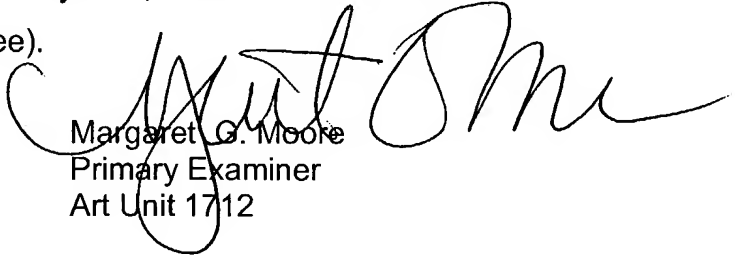
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be close enough as to render the claimed degree of unsaturation obvious. In this manner, the instantly claimed process would appear to have been obvious over the teachings of Stuart.

3. Claims 1 to 20 are objected to because of the following informalities: The phrase "The present invention relates to" should be deleted from the introductory clause in claim 1, as this is somewhat confusing and irregular. Appropriate correction is required. Also, in claim 3, reference to "the polyether urethane in claim 1" is incorrect, as claim 1 is drawn to a process.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
4/21/04